

Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed April 2, 2009. Currently, claims 1-32 remain pending of which claims 1-23 were previously withdrawn. Claims 24-32 have been rejected. Claims 24, 25, and 28-30 have been amended and claims 26, 27, 31, and 32 have been canceled. It is not believed that the material incorporated by reference will be relied upon to overcome an objection, rejection or other requirement imposed by the Office. Should that become necessary, the application will be amended as necessary at that time. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 112

Claims 24-32 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner has asserted that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time that the application was filed, had possession of the claimed invention. Possession may be shown in many ways. For example, possession may be shown by describing an actual reduction to practice of the claimed invention. A specification may describe an actual reduction to practice by showing that the inventor constructed an embodiment or performed a process that met all the limitations of the claim and determined that the invention would work for its intended purpose. *Cooper v. Goldfarb*, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998). (“[T]here cannot be a reduction to practice of the invention * * * without a physical embodiment which includes all limitations of the claim.”); *Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 593, 44 USPQ2d 1610, 1614 (Fed. Cir. 1997) (MPEP 2163. II., 3., (a).) The specification includes Tables 1 and 2, which summarize the results of testing samples of material prepared using the apparatus of the pending claims, and thus provides adequate evidence of a reduction to practice of the claimed apparatus. However, to advance prosecution, Applicants have amended claims 24, 25, 28-30 and canceled claims 26, 27, 31, and 32. As such, this rejection is considered moot.

The Examiner has also made reference to an invention involving a chemical genus. The text of the Office Action does not appear to identify the chemical genus to which the Examiner refers. As currently amended, the pending apparatus claims do not appear to rely upon a chemical genus other than to indicate that categories of materials well known to practitioners of this art may be added to a mixing chamber in the form of granules and/or solutions. Clarification of the comment in a future non-final Office Action is respectfully requested so that the Applicants may respond in a meaningful manner.

In discussing the correlation between structure and function, the Examiner has acknowledged that the level of skill and knowledge in the art is very high. What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1384, 231 USPQ at 94. >See also *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1085 (Fed. Cir. 2005)(“The ‘written description’ requirement must be applied in the context of the particular invention and the state of the knowledge.... If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972). Further, the Examiner’s attention is directed to the paragraph at page 7, lines 12-20. It is believed that the details of a specific implementation of the apparatus of the invention involve routine engineering in the selection of elements appropriate for the scale of the operation. For example, selection of a heat source capable of heating the mixing chamber necessarily depends upon whether the material to be processed by the apparatus will be present in sub-liter volumes or in multi-kiloliter volumes. Similarly, the mixing chamber, granule feeding system, and various addition elements will also be selected with the appropriate scale in mind. An eye-dropper is unlikely to be an appropriate element for adding 1,000 gallons of solution to a mixing chamber, but may be quite appropriate in a lab scale apparatus.

The Examiner has specifically mentioned an alleged lack of information regarding the temperatures to which the materials may be heated during the process. The

Examiner's attention is directed to the Example at page 15, lines 1-10 in which process times and temperatures are specified. In particular, attention is drawn to the temperatures of 34 °C and 90 °F.

The Examiner has also indicated that "No description is provided how to make the apparatus." An apparatus claim does not require a corresponding method of assembling the apparatus.

Claims 24-28 and 29-32 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 24, 25, and 28-30 to further prosecution of this case. As such, this rejection is considered moot.

Claim Rejections – 35 USC § 101

Claims 25-27 and 30-32 were rejected under 35 U.S.C. 101 because they overlap in two different statutory classes of invention. Applicant has amended claims 24, 25, and 28-30 and canceled claims 26, 27, 31, and 32 to further prosecution of this case. As such, this rejection is considered moot.

Claim Rejections – 35 USC § 102

Claims 24-32 were rejected under 35 U.S.C. 102(b) as anticipated by Markwardt et al. (U.S. Patent No. 4,924,764), hereinafter Markwardt. After careful review, Applicant must respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See MPEP § 2131). Nowhere does Markwardt appear to teach or suggest, "a water supply connected to the mixing chamber"; "a granule feeding system capable of feeding gelatin granules"; or two material addition elements, as recited in currently amended claims 24 and 29. The Examiner does not appear to have identified elements disclosed by Markwardt which correspond to each of the elements of the amended independent claims at issue. For example, Markwardt does not appear to

disclose a granule feeding system capable of feeding gelatin granules. Indeed, Markwardt does not appear to disclose a solids feeding system of any type as the “pressure beating machine is charged with a boiled mass of low viscosity”. (Col. 1, lines 59-61.)

Instead, Markwardt appears to teach a two chamber apparatus, neither of which has each of the recited claim elements of independent claims 24 and 29. For at least the reasons that aeration appears to occur in the pressure-beating machine and the pressure-beating machine is charged with a pre-existing sugar water mass prepared in a separate cooker and that Markwardt does not appear to anticipate the addition of at least water, gelatin, a cross-linking agent addition element, and a clot formation accelerator addition element to the pressure beating machine, Markwardt does not appear to disclose *each and every element as set forth in the claim* and to do so in the necessary detail with respect to the arrangement of the claimed elements.

“The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (MPEP 2131)

Accordingly, Markwardt does not appear to anticipate independent claims 24 and 29 and Applicants respectfully request that the rejections be withdrawn.

Additionally, for similar reasons as well as others, claims 25, 28, and 30, which depend from claims 24 and 29, and include significant additional limitations, are believed to be not anticipated by Markwardt and Applicants respectfully request that the rejections be withdrawn.

Claims 29-32 were rejected under 35 U.S.C. 102(b) as anticipated by Helbig et al. (U.S. Patent No. 4,502,228), hereinafter Helbig. After careful review, Applicant must respectfully traverse this rejection.

As currently amended, the comments regarding §112, sixth paragraph do not appear to be appropriate. Nowhere does Helbig appear to teach or suggest, “a water supply connected to the mixing chamber”; “a granule feeding system capable of feeding

gelatin granules"; or two material addition elements, as recited in currently amended claim 29. The Examiner does not appear to have identified elements disclosed by Helbig which correspond to each of the elements of the independent claims at issue. For example, Helbig does not appear to disclose a granule feeding system capable of feeding gelatin granules.

Instead, the Examiner has asserted that claim 29 will be broadly interpreted as "an apparatus that can heat solution by any means". The apparatus of Helbig does not appear to disclose heating a solution in air mixing chambers (4), the only mixing chambers disclosed by Helbig. Heating in the apparatus of Helbig appears to be confined to heating chamber (5) remote from mixing chamber (4). Similarly, the other claimed elements such as a water supply connected to mixing chamber (4) or an air injector to foam the contents of the mixing chamber (4) do not appear to be disclosed by Helbig. For these and other reasons, it is believe that Helbig does not disclose *each and every element as set forth in the claim* and Applicants respectfully request that the rejections be withdrawn.

Additionally, for similar reasons as well as others, claim 30, which depends from claim 29, and includes significant additional limitations, is believed to be not anticipated by Helbig and Applicants respectfully request that the rejection be withdrawn

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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